Remarks

In the office action, the Examiner has rejected claims 86 - 101 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 126-212 of copending application number 10/207,418. The Examiner has rejected claims 86, 89-90, 94, 97 and 100-101 under 35 U.S.C §103(a) as being unpatentable over AirMobile™ Wireless Comm Client for cc:Mail User Guide Version 1.0, Communication Client Guide, 1995 (hereinafter AirMobile), MAPI Developers Forum post "MAPI Notification" April 12, 1996 (hereinafter "Carthy") and United States Patent No. 5,764,899 (hereinafter "Eggleston"). The Examiner has rejected claims 87-88 under 35 U.S.C §103(a) as being unpatentable over AirMobile, Carthy and Eggleston in view of United States Patent No. 5,758,088 (hereinafter "Bezaire"). The Examiner has rejected claim 91 under 35 U.S.C §103(a) as being unpatentable over AirMobile, Carthy and Eggleston in view of MobileVision User Manual, CE Software, Inc., 1995 (hereinafter "MobileVision"). The Examiner has rejected claims 92-93 under 35 U.S.C §103(a) as being unpatentable over AirMobile, Carthy and Eggleston in view of United States Patent No. 5,812,671 (hereinafter "Ross"). The Examiner has rejected claims 95 and 98-99 under 35 U.S.C §103(a) as being unpatentable over AirMobile, Carthy and Eggleston in view of CE Software Announces MobileVision, CE Software, Inc., 1995 (hereinafter "Dunker"). The Examiner has rejected claim 96 under

PAGE 12/23 * RCVD AT 6/28/2006 11:12:21 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/22 * DNIS:2738300 * CSID:2143638177 * DURATION (mm-ss):04-20

35 U.S.C §103(a) as being unpatentable over AirMobile, Carthy and Eggleston in view of United States Patent No. 6,157,630 (hereinafter "Adler") or United States Patent No. 5,951,636 (hereinafter "Zerber").

The applicant has cancelled claims 86-101. The applicant has presented new claims 102-129 of which claims 102, 113 and 122 are in independent form. Favorable consideration of the present application as currently constituted is respectfully requested.

Double Patenting Rejection

The Examiner has rejected claims 86-101 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 126-212 of copending application number 10/207,418. The applicant has cancelled claims 86-101. Accordingly, the specific rejections to claims 86-101 are moot. Applicant notes, however, that if a provisional doubling patenting rejection is applied against the new claims, applicant will file a terminal disclaimer to obviate such a rejection in a timely manner.

Rejection under 35 U.S.C §103(a)

The Examiner has rejected claims 86, 89-90, 94, 97 and 100-101 under 35 U.S.C §103(a) as being unpatentable AirMobile, Carthy and Eggleston. The applicant has cancelled claims 86, 89-90, 94, 97 and 100-101. Accordingly, the specific rejections to claims 86,

PAGE 13/23 * RCVD AT 6/28/2006 11:12:21 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/22 * DNIS:2738300 * CSID:2143638177 * DURATION (mm-ss):04-20

89-90, 94, 97 and 100-101 are moot. Applicant notes, however, that arguments are presented below regarding these cited references as they apply to the presently pending claims.

The Examiner has rejected claims 87-88, 91-93, 96-96 and 98-99 under 35 U.S.C §103(a) as being unpatentable over AirMobile, Carthy and Eggleston in view of one or more of Bezaire, MobileVision, Ross, Dunker, Adler and Zerber. The applicant has cancelled claims 87-88, 91-93, 96-96 and 98-99. Accordingly, the specific rejections to claims 87-88, 91-93, 96-96 and 98-99 are moot.

New claims

The applicant has presented new claims 102-129. Each of the new independent claims, namely, claims 102, 113 and 122 includes the subject matter of cancelled claim 86 that applicant believes to be allowable. Specifically, each of the independent claims is directed to pushing user data items from a messaging host system to a wireless mobile data device that is associated with a computer connected over a network to the messaging host system including: receiving an automatically generated notification, generated in response to receipt of a user data item at the messaging host system, at a redirector component indicating receipt of the user data item by the messaging host system, wherein the user data item is addressed to a data store associated with the messaging host system and is viewable via the computer; processing a copy of the

PAGE 14/23 * RCVD AT 6/28/2006 11:12:21 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/22 * DNIS:2738300 * CSID:2143638177 * DURATION (mm-ss):04-20

user data item at the redirector component to add address information associated with the wireless mobile data device; and sending the copy of the user data item from the redirector component to the wireless mobile data device over a wireless network.

AirMobile

AirMobile is directed to an email forwarding scheme over a wireless network wherein two types of messaging delivery models are disclosed: (i) a "client poll" model and (ii) a "server push" model. The "client poll" model involves polling from the user's standpoint, i.e., the user needs to poll the host system by sending a request on a periodic basis to effectuate delivery of email messages from the host system to the user's device. The "server push" model, on the other hand, does not require the user to initiate contact with the host system to retrieve emails. AirMobile describes the "server push" model as excerpted below:

> With Motorola Air*Mobile*, messages are "pushed" out to your portable PC from the server over the wireless network; you do not have to constantly call in to check for messages. This implementation of "server push" eliminates unnecessary communication between the client and server, minimizing communication costs and artificial delivery delays.
>
> When you send a message while Motorola Air*Mobile* is running, the message will be immediately processed from your outbox, assuming it passes your upload filters, and be delivered to your LAN-based cc:Mail server for ultimate delivery.

PAGE 15/23 * RCVD AT 6/28/2006 11:12:21 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/22 * DNIS:2738300 * CSID:2143638177 * DURATION (mm-ss):04-20

> When a message arrives for you in your LAN-based cc:Mail inbox, Motorola Air*Mobile* software will immediately download the messages to your laptop, assuming it passes your download filters, placing it in your cc:Mail Mobile inbox. See page 31 of the *AirMobile Client* reference, at paragraphs 1-3.

As such, AirMobile teaches that its server software is required to poll a user's inbox at the mail server at a predetermined scheduler cycle period. Additionally, its server software is also required to poll the mail server at a predetermined inter-user time-out period. In other words, the email forwarding scheme disclosed in AirMobile is in fact a polling-based system that requires polling of the mail server by the AirMobile server software.

Accordingly, the scheme disclosed in AirMobile as a "server push" messaging model does not teach or suggest the presently claimed pushing of user data items from a messaging host system to a wireless mobile data device involving receiving an automatically generated notification at the redirector component indicating receipt of the user data item by the messaging host system and sending a copy of the user data item from the redirector component to the wireless mobile data device. The Examiner has conceded that AirMobile fails to teach such a wireless push system. Specifically, the Examiner stated in the office action that "Airmobile failed to specifically recite 1) using a software interface with the messaging server to automatically receive a notification signal when an electronic message is received and

PAGE 16/23 * RCVD AT 6/28/2006 11:12:21 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/22 * DNIS:2738300 * CSID:2143638177 * DURATION (mm-ss):04-20

stored in the mailbox associated with the wireless mobile communications device...."

Eggleston

Eggleston is directed to an system wherein one or more user devices (e.g., mobile station 105) communicate with a host/server 115 over an infrastructure including both a wireless system and a data network 130, as seen in figure 1. A communications server 110, including a virtual session manager and query manager, is coupled between the data network 130 and the host/server 115.

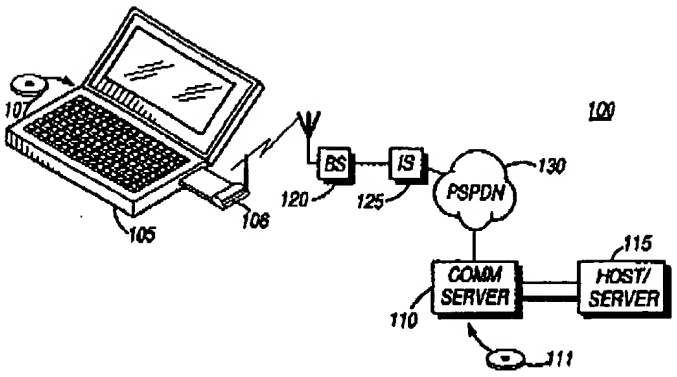


FIG.1

The virtual session manager is provided for establishing and maintaining a sessionless communication path with the mobile station 105 and a session-oriented

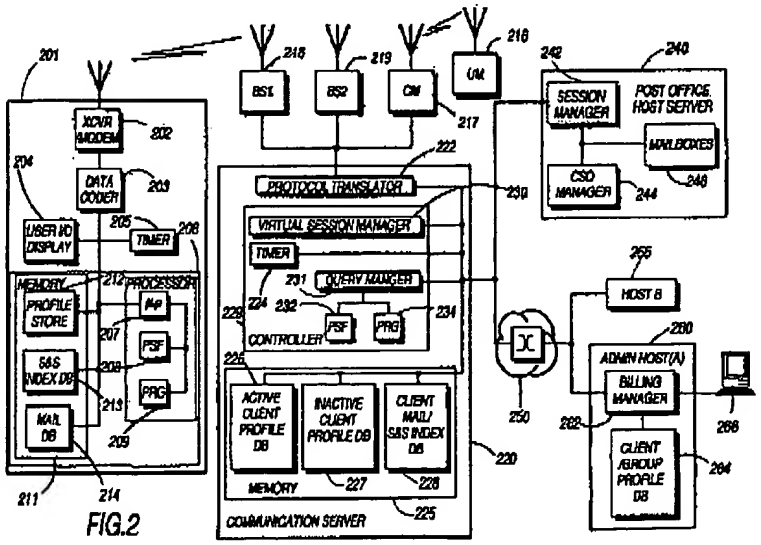


FIG.2

PAGE 17/23 * RCVD AT 6/28/2006 11:12:21 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/22 * DNIS:2738300 * CSID:2143638177 * DURATION (mm-ss):04-20

communication path with the host server 115. As described with respect to figure 2, which shows additional details of an exemplary communications server 220, a query manager 231 is operable for sending requests to a mail server to query for unprocessed messages.

Specifically, Eggleston teaches that a virtual session is established between the communications server 220 and the mobile station 201 via a registration process (see figure 3). Once the virtual session is established and in a manner similar to taught by AirMobile, the query manager 231 is programmed to send query objects at predetermined intervals for each application being run by each active mobile station requesting unprocessed data for that user from the mail server (see figure 3). As such, Eggleston teaches that communications server 220 is required to poll a user's inbox at the mail server at predetermined periods. In other words, the

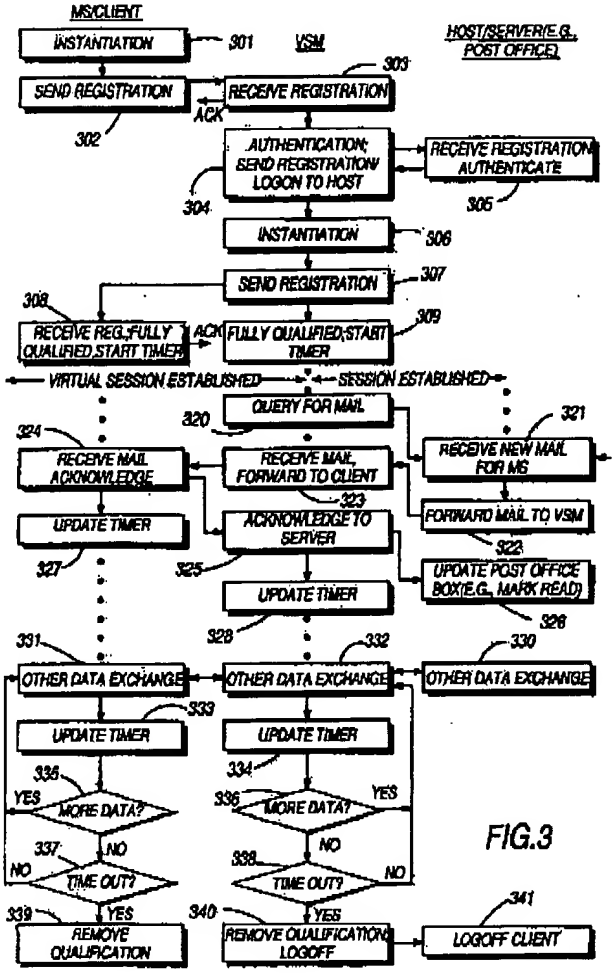


FIG.3

PAGE 18/23 * RCVD AT 6/28/2006 11:12:21 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/22 * DNIS:2738300 * CSID:2143638177 * DURATION (mm-ss):04-20

email forwarding scheme disclosed in Eggleston is in fact a polling-based system that requires polling of the mail server by the Eggleston communications server 220.

Accordingly, Eggleston does not teach or suggest the presently claimed pushing of user data items from a messaging host system to a wireless mobile data device involving receiving an automatically generated notification at the redirector component indicating receipt of the user data item by the messaging host system and sending a copy of the user data item from the redirector component to the wireless mobile data device.

Carthy

Carthy is directed to a response to a user question regarding the use of MAPI notifications. Specifically, the requester stated that:

> I want to notify an incoming message in any mailbox of my Exchange Server without connecting to the mailbox. In fact, I'd like to use something like a "full asynchronous" notification, without connection.
>
> Today I do a polling on each mailbox : I open a connection through MAPI functions, I consult, I notify if new mail, and I close the connection. Then I go to the next mailbox and do the same actions. It's not great :-(.
>
> So I'd like to know wether exists another way to notify with MAPI, especially a "full asynchronous" notification.

In response thereto, Ciaran Carthy stated that:

> "full asynchronous" notification is fully supported in extended MAPI.

PAGE 19/23 * RCVD AT 6/28/2006 11:12:21 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/22 * DNIS:2738300 * CSID:2143638177 * DURATION (mm-ss):04-20

> Assuming you have a pointer to Imsgtore object, do the following:
>
> ...
>
> Please refer to the mapi programming docs for an explanation of Advise function, and the IMAPIADVISESINK interface.
>
> You implement the IMAPIADVISESINK object which gets called back by MAPI when new mail arrives at the message store. However the notification "link" is only alive while you have the ImsgStore object open, so you must stay "connected".

Based upon this information, the Examiner states that it would be obvious to one of ordinary skill in the art at the time of the invention to incorporate the automatic notification functionality disclosed by Carthy within AirMobile's system. The Examiner attempts to support this position by stating that Carthy's disclosed automatic notification is preferable to polling and that use of automatic notifications is more efficient than polling.

Requirements for showing a prima facie case of obviousness

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

PAGE 20/23 * RCVD AT 6/28/2006 11:12:21 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/22 * DNIS:2738300 * CSID:2143638177 * DURATION (mm-ss):04-20

claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Examiner has suggested that it would be obvious to incorporate the teachings of Carthy relating to full asynchronous notification within AirMobile such that the AirMobile system would no longer need to poll the mail server to determine the arrival of new email messages. The applicant respectfully submits that the Examiner is in error because such a combination would necessarily involve a change in the principle of operation of the AirMobile system. As set forth above, the essential principle of operation of the AirMobile system is a "server push" system, which eliminates the need for the user to actually poll the host system, used in combination with a "server poll" system, which detects the presence of new messages. Removing the "server polling" operation of AirMobile and substituting therefor the full asynchronous notification of Carthy would require a substantial redesign of the AirMobile system and changes the basic operating principle under which AirMobile operates. As in the Ratti case, when the suggested

PAGE 21/23 * RCVD AT 6/28/2006 11:12:21 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/22 * DNIS:2738300 * CSID:2143638177 * DURATION (mm-ss):04-20

combination of references would require a substantial redesign of the primary reference as well as a change in the basic principle of operation of the primary reference, the combination of references is improper. *See Ratti*, 270 F.2d at 813, 123 USPQ at 352.

Also as set forth above, the essential principle of operation of the Eggleston system is the same as that of the AirMobile system. Specifically, the Eggleston system utilizes a "server push" system in combination with a "server poll" system. As such, removing the "server polling" operation of Eggleston and substituting therefor the full asynchronous notification of Carthy would require a substantial redesign of the Eggleston system and changes the basic operating principle under which Eggleston operates. Based on the foregoing analysis, Applicant respectfully submits that it is improper to combine the teaching of Carthy with those of either AirMobile or Eggleston.

Fee Statement

The number of independent claims is less than the highest number previously presented for examination and the total number of claims is less than the highest number previously presented for examination. Accordingly, the applicant believes no fees are due for the filing of this response. If any fees are due or any overpayments have been made, however, please charge or credit our deposit account (Deposit Account No. 03-1130).

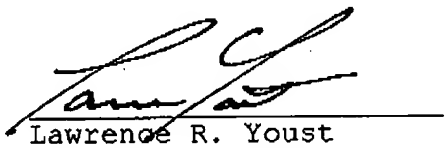
PAGE 22/23 * RCVD AT 6/28/2006 11:12:21 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/22 * DNIS:2738300 * CSID:2143638177 * DURATION (mm-ss):04-20

Conclusion

In view of the forgoing, the Examiner is respectfully requested to allow claims 102-129 presented for consideration herein. Accordingly, a favorable action in the form of an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned for any reason that would advance the instant application to issue.

Dated this 28th day of June, 2006.

Respectfully submitted:



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PAGE 23/23 * RCVD AT 6/28/2006 11:12:21 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/22 * DNIS:2738300 * CSID:2143638177 * DURATION (mm-ss):04-20